

## **REMARKS**

Claims 1-3, 7-12, 14-16, 22-26 and 81 and 82 have been amended. Claims 1-26, 81 and 82 remain in the application. Claims 27-80 have been withdrawn. No new matter has been added and the amendments are supported by the specification. The Applicants have noted the examiner's Section 112 and 103 rejections and respectfully request reconsideration and withdrawal of said rejections in view of the enclosed claim amendments and the discussion below.

### **Claim Rejections Based on 35 U.S.C. §112 Second Paragraph**

Claims 1-14 have been amended to address the examiner's 35 U.S.C. §112, second paragraph rejections.

### **Section 103 Rejections**

The Applicants note the examiner's rejection of Claims 1-5, 7-20, 22-26 and 81-82 under 35 U.S.C. § 103(a) as being unpatentable over Pant et al (U.S. Patent 6,012,053) and respectfully request reconsideration and withdrawal of said rejections in light of the following discussion and foregoing amendments.

"As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. MPEP Section 2141.

The factual inquiries enunciated therein as a background for determining obviousness are as follows:

1. determining the scope and contents of the prior art;

2. ascertaining the differences between the prior art and the claims of the invention at issue;
3. resolving the level of ordinary skill and the pertinent art; and
4. evaluating evidence of secondary considerations.

The results of each of these inquiries are weighed as a whole in making a factual determination of obviousness. Objective evidence of secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. “Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.” MPEP Section 2141.02. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *Id.* (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)).

“Distilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’” MPEP Section 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (restricting consideration of the claims to a 10% per second rate of stretching of unsintered PTFE and disregarding other limitations resulted in treating claims as though they read differently than allowed); *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 447-49, 230 USPQ 416,

419-20 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987) (district court focused on the "concept of forming ridgeless depressions having smooth rounded edges using a laser beam to vaporize the material," but "disregarded express limitations that the product be an ophthalmic lens formed of a transparent cross-linked polymer and that the laser marks be surrounded by a smooth surface of unsublimated polymer."); *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1984) ("treating the advantage as the invention disregards statutory requirement that the invention be viewed 'as a whole'"); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem)).

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP Section 2143.03.

"Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration

as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence *provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing* made by the examiner to support a particular ground of rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421. It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in

the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice."). *It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.* *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697. *As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.* *Id.* at 1385, 59 USPQ2d at 1697. MPEP Section 2144.03 (emphasis added).

See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the

substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). *Id* (emphasis added).

The Applicants respectfully submit that the present rejection of the Applicants' claims in the present office action fails to follow the above-referenced requirements. The invention has not been considered *as a whole* when comparing to the cited references, the invention has been reduced to the general thrust, ignoring the claimed elements, and the words in the claims have not been considered. Furthermore, no substantial evidence has been provided to support the examiner's assertion that use of telephone numbers was well known by those having ordinary skill in the art at the time that the present invention was made, which is the basis for the Section 103 rejections.

With regard to the examiner's rejection of Claims 1, 7, 14, 15, 16, 22, 81 and 82 the examiner relies on U.S. Patent No. 6,012,053 to Pant as disclosing every feature of the Applicants' claims except use of telephone numbers as search queries and then states that it is old and well known in the art to use telephone numbers as search queries. The Applicants resubmit that neither is true.

The Applicants submit that providing a cross-referencing system for providing access to websites corresponding to phone numbers using numeric phone numbers as the search query as claimed was not old and well known as of the Applicants' invention date, which is at least the Applicants' priority date, over 7 years ago. It was not old or well known to use telephone numbers as search queries, or to have telephone number and

domain name cross-referencing, or to provide a system whereby a user can enter a telephone number as a search query and obtain as search results a referential directory listing the telephone number and the domain name for the website corresponding to the specified telephone number, and also including additional websites that are comparable alternatives to the specified website based on comparison of gathered and stored data pertaining to the products or services offered by the websites and application of customizable criteria.

The Applicants request that examiner provide such substantial evidence in support of examiner's assertion that it was old and well known in the art to use telephone numbers as search queries. The examiner has only pointed to a couple of businesses that uses a spelled out 1-800 number as its corporate name and website address. That is not a directory system nor is it even a numeric phone number query-based system. The Applicant's respectfully submit that without documentary evidence supporting the examiner's assertion that it was old and well known in the art to use telephone numbers as search queries the assertion is baseless and improper. Such an assertion is not capable of such instant and unquestionable demonstration as to defy dispute.

The specific elements of the Applicants' claims cannot simply be ignored, and nowhere does Pant disclose any comparison of data regarding products or services provided by websites, or including software applications for correlating telephone numbers to domain names, much less doing both and also applying customizable criteria to render a directory. The examiner states in paragraph 8 of the office action that Pant discloses in Column 3, lines 33-41 and in Column 5, lines 22-25, the element in the Applicants' claim consisting of one or more software applications for correlating Internet

domain name data for a designated site and additional sites with their corresponding telephone number data. For the record, Column 3, lines 33-41 in Pant state as follows:

“A user supplies the search query 106 to the query engine 104 through a user interface 108. The database query engine 104 applies the search query 106 to the database 102 to provide search results 110 which include an indication of the items in the database 102 which match the search query 106. The search results typically include enough information to access the actual item, but generally does not include the entire item in order to reduce the amount of memory needed to process the search results.”

For the record, Column 5, lines 22-25 state as follows:

“In response to user input, the browser sends a message containing the search query and relevance factors to a designated server which processes the query.”

Neither of these passages in Pant, or the rest of Pant for that matter, say anything about “one or more software applications for correlating Internet domain name address data for a first merchant’s website and such merchant’s numeric telephone number and for correlating Internet domain name address data for additional merchants with their corresponding numeric telephone numbers.” How the noted passages of Pant can be said to disclose this feature of the Applicants’ invention is puzzling. To equate same is to ignore the clear wording of the Applicants’ claims.

The examiner has made the identical rejection for all of the independent claims together when the independent claims do not include the same elements. In fact, some are for a system and others are for a method. Yet the examiner has rejected method claims 14 and 82 in Paragraph 9 of the office action with reference to system elements from claim 1, ignoring the method steps of claims 14 and 82 entirely. Similarly, as to Claim



15, there is no mention in the rejection of such claim to any disclosure in Pant of the element of the Applicant's system consisting of means for gathering data comprising the Internet domain name addresses, numeric telephone numbers and data regarding their products and services and storing same in a database. Such rejections lack support and are improper.

Pant discloses a conventional search engine. The Applicants' invention is not a search engine. It is a directory system. Pant relies on word searching in documents and other online content, which is not useful for telephone number queries. Pant specifically states that it is based on statistical searching methods and Boolean search methods. See Pant, Col. 1, lines 13-31 and the relevance factors discussed in columns 6-12 are based on traditional search engine statistical and Boolean search methods. The Pant system would not produce the same result. IF a numeric telephone number was entered as the search query in the Pant system, the Pant search engine would scan websites for the occurrence of the number and then rank the hits based on the application of the relevance factors such as the position and/or frequency of the occurrence of the numeric telephone number in the item, and/or the distance between the terms in an item, the number of search terms found in the item, the ordering of search terms in the item, and other statistical and/or Boolean searching factors. It would not produce, from the single numeric telephone number query, a listing with the exact corresponding website and a referential directory of websites that are comparable, not based on the appearance of the numeric telephone number query in their websites, but rather based on a comparison of the products/services offered by the website corresponding to the telephone number query with the product/services offered by other sites, comparison of the geographic location of the

merchant of the website corresponding to the telephone number query and the geographic location of other sites, comparison of the price of the products/services offered by the website corresponding to the numeric telephone number query and the pricing of comparable products and services of other sites, and other customizable criteria as per the Applicants' claims. The Applicants' invention, as claimed, allows, through entry of a single numeric telephone number as a query, for the user to obtain access to the corresponding website of the merchant whose numeric telephone number was entered as a search query, and is able to generate, based on the same numeric telephone number query, a referential directory of additional websites that are comparable to the website of the merchant whose numeric telephone number was entered as a search query, based on the comparison of the stored information regarding the products/services, geographic location, pricing and other criteria for the website of the merchant whose numeric telephone number was entered as a search query and the stored information regarding the products/services, geographic location, pricing and other criteria for other websites. There is no searching to see if the numeric telephone number entered as a search query occurs within a document on the web, which would produce in Pant's system search results consisting of the same one site over and over again based on the location, frequency, distance between occurrences of the numeric telephone number in a document. Again, the present invention is a directory, not a search engine. The search results in the present invention are the website that directly corresponds to the merchant whose numeric telephone number was entered as a query, appearing once, together with a referential directory of additional sites that are comparable in their products, merchant's geographic location, prices and other customizable criteria. All of the search results are

relevant and ranking of relevant and less relevant search results is not necessary or a part of the present invention. Pant would not produce such a result because it would be searching for the occurrence of the first merchant's telephone number in other documents, and comparable websites would not normally have a competitor merchant's numeric telephone number listed in their pages.

Additionally, the examples given by the examiner with respect to a couple of websites that refer to their businesses by the word form of their 800 phone numbers (not the number only form) and refer to the business name in their website addresses are not relevant and do not teach any cross referencing of website addresses and telephone numbers. They simply are businesses that have used their telephone numbers IN WORD FORM as their brand, and have used their brand in their website name. The telephone numbers do not consist of numeric telephone numbers, but instead include mostly letters, not numbers, the numbers, when converted from numbers to letters, spelling out their business name. In those specific situations the telephone number is also the business name and also the website address and there is no cross-referencing of telephone numbers and website addresses, but rather, just searching for the occurrence of the business name in web documents as with the typical search engine. The Pant system would not work if the telephone number consists only of numbers rather than including mostly letters, and if the telephone number in word form is not also the business name and the domain name address as in the couple of examples provided by the examiner (e.g.1800flowers.com). It is requested that examiner try one or more typical search engines and type in as a search query "1800flowers.com" and compare the results to when the query is the numeric telephone number for same, i.e., "18003569377"-the clear undeniable difference in the

search results proves that the Applicants' invention performs a substantially different function in a substantially different way to achieve a substantially different result, and is not unpatentable based on Pant or examiner's assertion that use of telephone numbers as search queries is old and well known in the art. Ignoring the obvious distinction between such brands which include word forms of telephone numbers and numeric telephone numbers used as queries is unreasonable and improper.

Pant nowhere discloses any gathering and storing data comprising Internet domain names and telephone numbers corresponding to said websites' proprietors, or software applications for correlating Internet domain name data with telephone number data corresponding to the websites, and the Applicants respectfully submit that it was not old and well known in the art at the time the invention was made either. As the examiner notes, Pant does not disclose use of telephone numbers as search queries. Pant involves word searches and the relevance factors used in Pant would not function if the search queries are only telephone numbers or domain name addresses.

The additional features of applying customizable criteria and rendering a referential directory of comparable websites, based on a single query consisting of a numeric telephone number for one business with respect to which the user wants to access the corresponding website are further elements that are neither disclosed in Pant or were old or well known in the art at the time the Applicants' invention was made. Pant does not gather and store data pertaining to products or services offered by websites or cross-reference telephone numbers and domain names, and use both plus customizable criteria to render a referential directory of selected sites that are comparable alternatives to each other. Instead, Pant teaches application of a scoring system to rank search results

for word queries using relevance factors that would not work for telephone number queries, and the Pant search results are generated not based on comparison of stored data regarding the products or services offered by each website, but rather on the scores from applying the Pant relevance factors. Pant teaches providing search engine users with a way to order their search results by various relevance factors specified in columns 6-10 of Pant.

Pant teaches relevance factors based on:

- frequency of occurrence of search terms,
- position of search terms in document,
- number of search terms found in document,
- ordering of search terms within documents,
- distance between search items in document, and
- length of search terms based on stemming.

None of the relevance factors disclosed would apply to or work if the query is a telephone number and the desired search result is the corresponding website and a referential directory of comparable websites. They all relate to words as search terms. The Applicants' invention does not perform substantially the same function substantially the same way to achieve substantially the same result as Pant.

As such the Applicants submit that the invention as claimed in the Applicants' claims as amended is not unpatentable under 35 U.S.C. Section 103 based on Pant and examiner's assertion that use of telephone numbers as search queries is old and well known. Furthermore, given that the Applicants' independent claims 1, 14 and 15 are not

obvious, the Applicants' dependent claims 2-5, 8-13, 17-21 and 23-26 are not obvious either.

The Applicants respectfully submit that the invention as a whole does not constitute an obvious use or processing of "nonfunctional descriptive subject matter" as asserted by the examiner. On the contrary, entering an address for a business via one telecommunication means (i.e., telephone number) and be able to obtain the website corresponding to said business, via cross-referencing of telephone numbers and website domain name addresses is functional, as is providing, based on that one numeric telephone number for the one merchant, a referential directory with the website address and phone number of not only the website corresponding to the telephone number entered by the user, but also additional websites that are comparable alternatives based on customizable criteria, all from a simple phone number query. In Pant there is no database of telephone numbers and website address data or software applications correlating all such telephone numbers with corresponding address data, or software applications that compare the product/service data of a website corresponding to a phone number query and the product/service data of other websites and further apply customizable criteria to render a directory showing the phone number and website address for not only the website corresponding to the one telephone number queried, but also for the selected sites, which are comparable alternatives to the specified website. The Applicants further request that examiner provide legal support for examiner's rationale that a telephone number is "nonfunctional descriptive matter" and for the proposition that something that is deemed to be "nonfunctional descriptive matter" in a claim is per se unpatentable and/or is not a claim limitation to be considered as with any other claim limitation. The


Applicants respectfully submit that such basis is not a valid basis for determining patentability.

The Applicants respectfully submit that the application and claims, as amended, are in condition for allowance and request that examiner withdraw the rejections and allow the case. Nonetheless, should the examiner still have any comments, questions or suggestions, the examiner is respectfully requested to telephone the undersigned at the telephone number listed below.

Date: March 30, 2009

Respectfully submitted,

GREENBERG TRAURIG, P.A.  
1221 Brickell Avenue  
Miami, Florida 33131  
Tel: (305) 579-0812  
Fax: (305) 579-0812  
Email: mrv@gtlaw.com

  
\_\_\_\_\_  
Manuel R. Valcarcel, Esq.  
Reg. No. 41,360

MIA 180,355,988v2 3-31-09

Express Mail Mailing Label No. EM 298581339US